

REMARKS

Claims 1-32, 34-46 and 49-55 are pending.

Claims 1-32, 34-46 and 49-55 stand rejected.

Claims 2, 3, 23, 24, 33, 47, 48, 52 and 53 have been previously canceled, without prejudice.

Claims 1, 22, 32, 46, 49 and 50 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

This response is submitted in response to a Final Office Action and is deemed to place the application in a condition for allowance, or alternatively, in better condition for appeal.

35 USC §103(a) REJECTION

Claims 1, 4-22, 25-32, 34-46, 49-51, 54 and 55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yoseloff (U.S. Patent No. 6,398,645) and further in view of Falciglia (U.S. Patent No. 5,935,002).

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 1, 4-22, 25-32, 34-46, 49-51, 54 and 55.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although

Applicant: Jon P. Yarbrough
Serial No.: 10/797,338
Group Art Unit: 3714
Examiner: Sunit Pandya

the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. 112, fourth paragraph.

Each of independent claims 1, 22, 32, 46, 49 and 50 recite, among other things, that *the mechanical technological aid is selected from the group of one or more mechanical spinning reels rotatable about at least one axle, one or more mechanical spinning wheels rotatable about at least one axle, one or more mechanical die rotatable about at least one axle, one or more mechanical playing cards rotatable about at least one axle, and combinations thereof.*

The Examiner correctly noted that Yoseloff is completely silent with respect to “displaying the end game result represented by a mechanical technological aid” and that “instead Yoseloff teaches [of] video reels.” (emphasis added).

As previously noted, Yoseloff teaches away from the claimed inventions in that he specifically states, as the Examiner has already previously acknowledged, that the “use

of mechanical devices is awkward, inconvenient and cumbersome" (see column 2, lines 1-2). Furthermore, element 144, as best understood by the Applicant, is shown (e.g. in Fig. 1) as being a video display, and there is absolutely no description whatsoever that element 144 can include one or more spinning members rotatable about an axle. Additionally, the Applicant respectfully takes issue with the Examiner's assertion that Yoseloff "teaches ... video reels" with respect to the award representation of the end game result. There is no description in Yoseloff that the award representation of the end game result, such as element 144 in Fig. 1, is displayed as a "video reel." The only apparent disclosure of an "end game result" is shown in Fig. 1 at element 144, which appears to be a simple static video display. Presumably, the device disclosed by Yoseloff can change the display information on the video display, but there is no mechanical (e.g., rotational) movement of any members about an axle. Thus, one of ordinary skill in the art would not look to Yoseloff for guidance on a bingo-type game, or method of using the same, as presently claimed.

The Examiner apparently cited Falciglia to remedy the deficiencies in the disclosure of Yoseloff. However, Falciglia suffers from its own deficiencies, as well.

Neither Yoseloff and/or Falciglia, either alone or in combination therewith, disclose or suggest the invention as claimed in any of independent claims 1, 22, 32, 46, 49 and/or 50, as amended, or the claims dependent therefrom.

The passage at column 11, lines 23-30, of Falciglia that was partially cited by the Examiner is reproduced below:

As shown in FIG. 8, the game client 170 includes an event processor 196 connected to a user input device 198, a game display 200, and a communications interface 202. The event processor 196 operates the application program for allowing the

user to play the bingo-like game. The event processor 196 performs wheel spins; i.e. the event processor 196 operates the selectable symbol generator to generate a new set of five random symbols and to change a current display of the selectable display regions to display the generated random symbols to simulate the spinning of multiple mechanical wheels generating random symbols as in slot machines in the prior art. (Emphasis added).

Thus, Faciglia merely endeavors to simulate the “mechanical” spinning of game symbols, but it is actually a video representation of spinning symbols. That is, there is no disclosure or suggestion of a “physical” axle upon which “physical” technological aids (whatever form they may take) actually rotate thereabout. Furthermore, Faciglia does not disclose or suggest that the video simulation of the game symbols are used to indicate an end game result, as presently claimed, but rather appear to be part of the primary game itself. Thus, as with Yoseloff, it is clear that Faciglia teaches away from the claimed inventions in that it specifically teaches that video representations, as opposed to mechanical technological aids, are to be used to depict game symbols or other game-related indicia. Therefore, one of ordinary skill in the art would not look to Yoseloff and/or Faciglia, either alone or in combination therewith, for guidance on a bingo-type game, or method of using the same, as presently claimed.

Because claim 1 is allowable over Yoseloff and/or Falciglia, either alone or in combination therewith, for at least the reasons stated above, claims 4-21, which depend from and further define claim 1, are likewise allowable. Because claim 22 is allowable over Yoseloff and/or Falciglia, either alone or in combination therewith, for at least the reasons stated above, claims 25-31, which depend from and further define claim 22, are likewise allowable. Because claim 32 is allowable over Yoseloff and/or Falciglia, either alone or in combination therewith, for at least the reasons stated above, claims 34-46,

Applicant: Jon P. Yarbrough

Serial No.: 10/797,338

Group Art Unit: 3714

Examiner: Sunit, Pandya

which depend from and further define claim 32, are likewise allowable. Because claim 50 is allowable over Yoseloff and/or Falciglia, either alone or in combination therewith, for at least the reasons stated above, claims 51, 54 and 55, which depend from and further define claim 46, are likewise allowable.

Accordingly, the Applicants contend that the 35 U.S.C. §103(a) rejection of claims 1, 4-22, 25-32, 34-46, 49-51, 54 and 55 has been overcome or rendered moot.

Applicant: Jon P. Yarbrough
Serial No.: 10/797,338
Group Art Unit: 3714
Examiner: Sunit, Pandya

CONCLUSION

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by Examiner in the Final Office Action of June 16, 2008 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 723-0487 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PC.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

October 6, 2008
Date

/James R. Yee/
James R. Yee, Registration No. 34,460
The Pinehurst Office Center, Suite #101
39400 Woodward Avenue
Bloomfield Hills, Michigan 48304
(248) 723-0349